

REMARKS/ARGUMENTS

Claims 1-13 are now active in this application.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 1-7 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Freedman (USPN 4,839,829)

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

There are significant differences between the claimed invention and the arrangement disclosed by Freedman that scotch the factual determination that Freedman identically describes the claimed inventions within.

With respect to independent claim 1 (and dependent claims 2-7), column 10, lines 11-19 (identified by the Examiner) of Freedman describe:

...Alternatively, it may be desirable to insert an additional graphic at some point in the text to fill up the last page or to insert an advertisement, form or coupon on the last or some other page for efficient usage of all pages.

Assuming that the requester makes no further changes, the computer then calculates cost information utilizing alternate pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities.

As can clearly be seen, there is no disclosure or suggestion of an alteration means for altering printing fees for document images based on times required for forming the additional images, as required by claim 1. More specifically, while Freedman does mention inserting an advertisement, for or coupon, there is nothing that discloses that there would be an alteration of printing fees because of this, or that any such alteration would be based upon times required for forming the additional images. Freedman does not recognize that printing can take longer if, for example, the additional image is inserted as an extra page or is printed on the rear side of the document, as in the present application.

A rejection under 35 U.S.C. § 102 requires certainty that each element of the claim is found, either expressly described or under principles of inherency, in the single prior art reference (Freedman). There is no certainty that Freedman discloses altering of printing fees when an additional image is formed, or if there were an alteration of printing fees, such alteration would be based on times required for forming the additional images. For example, if it presumed that Freedman discloses altering of printing fees when an additional image is formed, the altered printing fees can be based on a fixed fee for each additional image formed.

With respect to independent claim 13, while column 10, lines 19-24 (identified by the Examiner) of Freedman describe:

Assuming that the requester makes no further changes, the computer then calculates cost information utilizing alternate pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The requester is then provided with information regarding the various job costs, timing, etc. and is given the opportunity to select a particular printing facility or a particular machine or mix of machines for production of the job.

As can be seen, there is clearly no disclosure or suggestion of displaying information concerning altered fees on the display, as is required in claim 13, at this portion of Freedman. In the

present application, as described from page 19, line 24 to page 20, line 4, there is a specific identification (in the display) of the printing fees altered by the alteration means.

The above differences between the claimed system and the system of Freedman undermines the factual determination that Freedman identically describes the claimed invention within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1-7 and 13 under 35 U.S.C. § 102 for lack of novelty as evidenced by Freedman, is not factually or legally viable. Consequently, withdrawal of the rejection of claims 1-7 and 13 under 35 U.S.C. § 102(b), as well as the allowance of claims 1-7 and 13, are respectfully solicited.

II. Claims 8-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman in view of Markowitz. The Examiner admits that Freedman does not teach a memory unit that stores multiple additional images. Markowitz is relied upon to disclose a telephone network carrying a facsimile transmission that modifies the users facsimile transmission by incorporating at least one advertisement with the user's facsimile transmission that includes a memory unit that stores multiple additional images. The Examiner maintains that it would have been obvious to one of ordinary skill in the art to modify Freedman to include the memory unit that stores multiple additional images, as taught by Markowitz.

The rejections are respectfully traversed.

In imposing a rejection under 35 U.S.C. §103, the Examiner is charged with the initial burden of identifying a source in the applied prior art for the requisite motivation to combine

references with a reasonable expectation of achieving a specific result. *Smiths Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). That burden has not been discharged. In this respect, Applicant would stress that the requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). It has been judicially held that a generalization does not establish the requisite legal motivation to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995).

In applying the above legal tenet to the exigencies of this case, Applicants submit that the Examiner's obviousness conclusion is legally erroneous as it lacks the requisite motivational element to combine the references to meet the terms of the claims. Since the Examiner provides no motivation to combine the references to meet the terms of the claims, the only conclusion is that the motivation is found in Applicants' disclosure, which can not be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

In Freedman, as admitted by the Examiner, there is no memory for storing multiple additional images. In this regard, since no multiple additional images are memorized, it naturally follows that the concept of "selection" does not exist. Consequently, an alternation means for altering fees based on selected additional images, is also absent.

Markowitz barely discloses the fact that multiple additional images are memorized, let alone that a control of some sort or other is effected, depending on additional images, or that fees are

altered based on selected additional images. Given these fact, the claimed invention does not result even if the teaching of Markowitz were some combined with the arrangement of Freedman. More specifically, if the teaching of Markowitz were some combined with the arrangement of Freedman, such combination would have no alteration means for altering fees based on selected additional images, as there is nothing in these references that evinces that such an alteration means is even considered.

Consequently, independent claim 12, claim 8 depending from claim 1, and claim 9 depending from claim 8 are patentable over Freedman and Markowitz, considered alone or in combination, and there allowance is respectfully solicited.

Independent claim 10 requires the system to have an additional image mode that forms only the additional images without printing any document images. No such additional image mode is disclosed or suggested in Freedman or Markowitz, considered alone or in combination.

Consequently, independent claim 10, and claim 11 depending from claim 10, are patentable over Freedman and Markowitz, considered alone or in combination, and there allowance is respectfully solicited also.

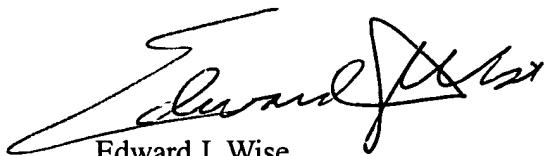
## CONCLUSION

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY



Edward J. Wise  
Registration No. 34,523

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 EJW:cac  
Facsimile: (202) 756-8087  
**Date: September 29, 2003**